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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,562	02/05/2004	Timothy Paddock	0978-0027	5513

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EXAMINER	
BOTTORFF, CHRISTOPHER	

ART UNIT	PAPER NUMBER
3618	

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/772,562	PADDOCK, TIMOTHY	
	Examiner	Art Unit	
	Christopher Bottorff	3618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 December 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *15-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *15-20,22-24 and 26* is/are rejected.

7)☒ Claim(s) *21,25 and 27* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *05 February 2004* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

The amendment filed December 13, 2004 has been entered. Claims 1-14 are canceled. Claims 15-27 are added.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the front end of the deck that is similar to the rear end, as defined in claim 26, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 15, 17-19, 22, 23, 24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kroher EP 0 620 031 B1 in view of Hokanson US 3,990,713.

Kroher discloses an all-terrain board comprising an elongate deck structure 1 having an upper surface, a lower surface, a front end, a central portion, and an upturned rear end defining a kicktail 2. See Figures 1 and 2. Front and rear wheels 4 are respectively mounted at the front and rear ends of the deck structure 1. See Figures 1 and 2. The wheels 4 are mounted on respective front and rear axle assemblies 3 pivotally mounted to the upper surface of the deck structure 1 above the plane of the central portion of the deck structure. See Figure 1. The central portion, which supports loops 14, is disposed between the wheel axes and extends below the level of a plane defined by the wheel axes. See Figures 1 and 2. The central portion provides a front position for one of a rider's feet. See Figure 1. The kicktail 2 extends upwardly and rearwardly within a rear wheel radius to a position disposed outward of the rear wheel radius, thereby providing a substantially supported rear position for the rider's other foot

behind the rear wheel. See Figures 1 and 2. The substantially supported rear position is substantially above the plane defined by the central portion of the deck structure. See Figure 2.

The deck structure 1 extends under and is suspended below the wheel axes. See Figure 2. A member 10 that limits the angle through which the axle can pivot relative to the board connects each end of the axle to the deck structure 1. See Figure 2. Also, the front end 2 of the deck structure has a similar structure to the rear end 2 of the deck structure. See Figures 1 and 2.

In regard to limitations that recite a component's intended use, such as "to provide a substantially supported rear position for the rider's other foot behind said rear wheel", claims containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all of the structural limitations of the claims. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). Kroher teaches all of the claimed structural limitations discussed above, including the kicktail. Thus, the claimed intended use of the kicktail of the present invention does not differentiate the claimed invention from the kicktail of Kroher.

Kroher does not disclose an elongate strengthening member extending axially of the longitudinal axis of the deck structure such that the strengthening member is fitted to the deck structure above the lower surface of the deck structure and extends rearwardly along the deck from a point in front of the rear wheel axis to a point on the kicktail. However, Hokanson teaches the desirability of such a strengthening member. See

column 1, lines 9-11, 27-31, 38-44, 57-61, and 66-68; column 2, lines 1-3, and, 9-17. The strengthening member 11 extends axially of the longitudinal axis of the deck structure such that the strengthening member 11 extends rearwardly along the deck from a point in front of the rear wheel axis to a point on the kicktail. See Figures 4 and 5. The strengthening member 11 forms a base of the rear axle assembly. See column 3, lines 36-42. Also, the strengthening member 11 may be integrally molded in the body of the skateboard and, therefore, is fitted to the deck structure above the lower surface of the deck structure. See column 3, lines 64-67. From the teachings of Hokanson, providing the board of Kroher with the claimed strengthening member would have been obvious to one of ordinary skill in the art at the time the invention was made. This would help to protect the end from damage and would provide the end with strength. See column 2, lines 13-17.

Furthermore, in regard to claim 23, Hokanson teaches the desirability of fitting the strengthening member 11 to the same side of the deck structure as the surface upon which the axle assembly is mounted. See Figures 4 and 5. Since the axle assemblies of Kroher are provided on the upper surface of the deck structure, fitting the strengthening member to the upper surface of the deck structure of Kroher would have been obvious to one of ordinary skill in the art at the time the invention was made. This would provide the strengthening member on the same side of the deck structure as the surface upon which the axle assembly is mounted, consistent with the teachings of Hokanson.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kroher EP 0 620 031 B1 in view of Hokanson US 3,990,713 as applied to claim 15 above, and further in view of Barachet US 5,160,155.

Kroher does not disclose that the kicktail 2 extends upwardly and rearwardly to a point substantially in-line with or above the plane defined by the wheel axes. However, Barachet teaches the desirability of extending a kicktail 18 of a sports board upwardly and rearwardly to a point substantially above a plane defined by the wheel axes 3 and 8. See Figure 1. From the teachings of Barachet, extending the kicktail of Kroher upwardly and rearwardly to a point substantially above the plane defined by the wheel axes would have been obvious to one of ordinary skill in the art at the time the invention was made. This extension of the kicktail would further protect the deck structure and the assemblies fitted on the deck structure by increasing the protective barrier provided at the end.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kroher EP 0 620 031 B1 in view of Hokanson US 3,990,713 as applied to claim 19 above, and further in view of Cole & Bondurant US 1,123,686.

Kroher does not disclose that each axle is pivotable against a resilient bias. However, Cole and Bondurant teach the desirability of providing a resilient bias *i* on a pivotable axle of a sports board. See Figures 1 and 3 and page 1, lines 65-68. From the teachings of Cole and Bondurant, providing the axles of Kroher with a resilient bias against which to pivot would have been obvious to one of ordinary skill in the art at the

time the invention was made. This would help maintain the axles in their normal positions.

Allowable Subject Matter

Claims 21, 25, and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 21 defines the resilient bias as being provided by an elastomeric member. Claim 25 defines the pivot limiting member as comprising a rigid strut having a coupling at an end. Claim 27 defines the strengthening member of the rear wheel axis as having a forward extension that is greater than the rearward extension. These features, in combination with the further limitations of the claim, are not taught by the prior art.

Response to Arguments

Applicant's arguments filed December 13, 2004 have been fully considered but they are not persuasive.

Applicant asserts that the board of Kroher is a down hill board, and a down hill board is different from the present invention since the present invention is allegedly a freestyle board. However, the rejected claims do not capture any such distinction. The claims define an all-terrain board rather than a freestyle board, and all-terrain boards comprise a broad family of boards including down hill boards. As noted above, the manner in which Applicant's claimed board is intended to be used, such as for

supporting a foot on the rear end or performing freestyle maneuvers, does not differentiate the claimed board from the board of Kroher.

Applicant also contends that the board of Kroher does not have a kicktail and does not provide a position that substantially supports the rider's rear foot beyond the radius of the rear wheels. However, the examiner respectfully disagrees. End 2 of Kroher is a kicktail within the meaning of the claims in that it is an upturned end that extends upwardly and rearwardly within the rear wheel radius to a position disposed outward of the rear wheel radius, as depicted in Figures 1 and 2. The term "kicktail" does not imply additional structure and additional structure is not defined in the claims in a way that would distinguish over the cited prior art. Furthermore, end 2 positioned at the rear of the board could, in use, substantially support the rider's rear foot beyond the radius of the rear wheels. While end 2 may not be optimal for accommodating a foot, the structure of end 2 could support a foot when the board is in use. The ability to support a foot, even if awkward, is sufficient to satisfy Applicant's claims since the structure of the kicktail is not defined in the claims in such a way that would require a degree of support in excess of the support provided by end 2 of Kroher. In addition, the desirability of providing a sports board with a kicktail is old and well known in the sports board art, as demonstrated in the references previously cited by the examiner. Providing such a common feature on the board of Kroher would at least be obvious.

In regard to the combination of Barachet and Kroher, the examiner does not suggest that the kicktail of Barachet, including the extension of the deck structure between the rear wheels and the kicktail, be bodily incorporated into the board of

Kroher. Rather, the combination suggests extending the upward and rearward extending portion of the kicktail of Kroher so that the portion rises to a point substantially in-line with or above the plane defined by the wheel axis. This upward and rearward extension would not render the board of Kroher unusable as suggested by Applicant. Moreover, Applicant's contention that the board of Kroher is prohibitively close to the ground to accommodate a kicktail extension is speculation based upon the unsubstantiated assumption that wheels 4 of Kroher each have a small diameter. The limits of the diameters of Kroher's wheels 4 are not disclosed and may be sufficiently large to suspend the deck structure sufficiently above the ground. Also, Smisek US 5,267,743 (previously cited) demonstrates that the combination of a close to the ground deck and an extended kicktail does not render a board unusable.

Also, as discussed in the rejection above, providing the board of Kroher with the claimed strengthening member would have been obvious. The primary focus of Hokanson's member 11 is to provide strength to the deck structure for applying increased leverage forces on the kicktail, contrary to Applicant's assertion. This is explained in column 1, lines 27-31, 38-44, 57-61, and 66-68; column 2, lines 1-3, of Hokanson. Member 11 has other purposes such as braking, skidding, and protecting the skateboard, but these additional purposes do not mitigate the strengthening ability of member 11. Furthermore, although providing the board of Kroher with a strengthening member would address problems associated with increased leverage forces that might snap a deck that is not strengthened, the ability of the strengthening

member to protect the skateboard from damage, as discussed in column 2, lines 14-17, of Hokanson, is sufficient to motivate the use of such a member on the board of Koher.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Bottorff whose telephone number is (703) 308-2183. The examiner can normally be reached on Mon.-Fri. 7:30 a.m. - 4:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis can be reached on (703) 308-2560. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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